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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/971,903	11/17/97	HARUKI	H 826.1431/JDH

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LM02/0113

EXAMINER
MYHRE, J

ART UNIT	PAPER NUMBER
2765	

DATE MAILED: 01/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/971,903

Applicant(s)
Haruki et al

Examiner
James Myhre

Group Art Unit
2765



☒ Responsive to communication(s) filed on Nov 17, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "25" and "28" have both been used to designate "menu module" in Figures 3, 4 and 5. Furthermore, reference character "28" has been used to designate both "Registration Change Process" in Figure 3 and "Menu Module" in Figures 4 and 5. Correction is required. Correction is required.

Specification

2. The disclosure is objected to because of the following informalities:
On page 23, line 5 and on page 25, line 16, "menu module" is referenced as item 25 instead of item 28 as it was originally referenced on page 16, line 10.
Appropriate correction is required.

Claim Objections

3. Claims 1 and 2 are objected to because of the following informalities:
 - a. Claim 1 has an extra space between "product" and the ";" on line 11 which should be deleted.

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b. Claim 2 is dependent upon itself (line 20). Examiner assumes the claim is dependent upon Claim 1 and will evaluate the claim under this assumption.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10, 12, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-9 recite a system comprised of non-functional descriptive material per se. The claims merely recite the components and objectives of the system without describing the methods used to achieve these objectives. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory (*Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760). Therefore, Claims 1-9 are considered for the purpose of analysis under 35 U.S.C. 101 as being directed to non-statutory matter.

Claim 10, 12, and 14 recite non-specific machines holding computer programs per se and merely manipulate an abstract idea without limitation to any practical application. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some usefulness (*Sakar* 558, F.2d at 1335, 200 USPQ at 139).

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Therefore, Claims 10, 12, and 14 are considered for the purpose of analysis under 35 U.S.C. 101 as being directed to non-statutory matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-4 and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill (5,761,649).

Claims 1 and 10-13: Hill discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means for managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 5, lines 57-67); and

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 5, lines 51-57).

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Claim 2: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 1 above, and further discloses means for the user to request new information about a product from the general management means (col 5, lines 4-30).

Claim 3: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 4, lines 11-15; col 5, lines 30-36; and col 9, lines 46-48).

Claim 4: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses:

- a. A personal identification number as part of the registration information (col 4, lines 15-31); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 3, lines 9-31).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 7-9, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (5,761,649) in view of Peschel, Joe, Infoworld.

Claims 7, 8, 14 and 15: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, but does not explicitly disclose multiple vendors updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user. Peschel discusses a software application called *Oil Change* from CyberMedia Inc. which automatically updates application and drivers on a user's computer by connecting to a centralized external database. Peschel further discusses allowing vendors (companies) to directly update the information about their products in the database (page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Hill's general management means' database by connecting to one or more external vendors and to allow them to update their product's information. One would have been motivated to do this in order to increase the number of software products that Hill's system could update and to ensure that the database contained the latest information available from each vendor as discussed by Peschel.

Claim 9: Claims 10-15: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and Peschel discusses *Oil Change* which allows vendors to update the centralized database. Peschel further discusses *Oil Change* using a database which contains the information about the latest versions of products, but which connects the user to the vendor's system to actually download the complete "fix" or update (using Yellow

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Pages)(Page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include links to vendors in the database. One would have been motivated to include links to the vendors in order to decrease the size of the database, thus increasing the efficiency and speed by which the system could respond to an inquiry from a user.

10. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (5,761,649).

Claims 5 and 6: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, but does not explicitly disclose basing the automatic update of the software on the number of times the application had been accessed. Official notice is taken that it is old and well known within the technological art to conduct periodic checks of software and that these checks could be based on a time limit or a maximum number of uses. An example of using the usage number in the industry is the “demo” software programs available from vendors. A demo is normally able to be used for a limited number of times, after which it either erases itself, prevents the user from activating the program, or it merely notifies the user that the “free use” period has expired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check the software applications being tracked by Hill’s invention and that these checks could be based on usage or time. One would have been motivated to track them by the number of times the software had been used in order to minimize the number of updates by ensuring the software with the highest

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usage level is always at the most up-to-date status possible and the software which is seldom used is only updated when it needs to be used.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Bullock et al (5,351,186) discloses a system and method for obtaining information about a product using a remote computer database with information provided by vendors. This reference could be used in support of the Hill reference in an 35 U.S.C. 103 rejection of Claims 1, 2, 4, 7, 8, and 10-15.

b. Richardson, III (5,490,216) discloses a system for automatic software registration built into a software application and activated upon installation of the software into a user's computer. This reference could be used in support of the Hill reference in an 35 U.S.C. 103 rejection of Claims 1, 3, and 4.

c. Bains et al (5,579,222) discloses a system which tracks software product usage after the product has been registered. This reference could be used in support of the Hill reference in an 35 U.S.C. 103 rejection of Claims 1, 5, and 6.

d. Bramnick et al (5,745,766) discloses a method for software product registration and tracking, to include updating. This reference could be used in support of the Hill reference in an 35 U.S.C. 103 rejection of Claims 1 and 3.

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e. Wyman (5,745,879) discloses a system and method for managing software product through registration and tracking. This reference could be used in support of the Hill reference in an 35 U.S.C. 103 rejection of Claims 1, 12, and 13.

f. Kullick et al (5,764,992) discloses an apparatus and method for automatic software replacement.

g. Goldsborough, Reid, NetGuide, discusses web support sites from which a user can download updates or get information and support.

h. Dyszel, Bill, Window Sources, discusses the CyberMedia software product, Oil Change, and could be used in support of the Hill reference in an 35 U.S.C. 103 rejection for Claims 4 and 8-11.

i. Gralla, Preston, PC/Computing, discusses the CyberMedia software product, Oil Change, and could be used in support of the Hill reference in an 35 U.S.C. 103 rejection for Claims 4 and 8-11.

j. Miastkowski, Stan, PC World (12/01/96), discusses the CyberMedia software product, Oil Change and could be used in support of the Hill reference in an 35 U.S.C. 103 rejection for Claims 4 and 8-11.

k. Miastkowski, Stan, PC World (01/01/97), discusses several CyberMedia web updating and fixing software products to include Oil Change and could be used in support of the Hill reference in an 35 U.S.C. 103 rejection for Claims 4 and 8-11.

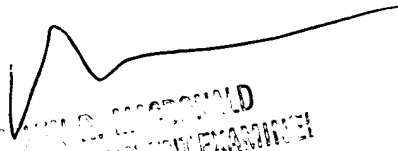
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen R. MacDonald, can be reached on (703) 305-9708. The fax phone number for this Group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-3900.


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01/07/99


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